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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,813	12/05/2003	Biplav Srivastava	JP920030179US1	1921

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EXAMINER

PANNALA, SATHYANARAYA R

ART UNIT

PAPER NUMBER

2164

DATE MAILED: 05/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/729,813

Applicant(s)

SRIVASTAVA, BIPLAV

Examiner

Sathyanarayan Pannala

Art Unit

2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. Application No. 10/729813 filed on 12/5/2003 has been examined. In this Office Action, claims 1-15 are pending.

#### ***Specification***

2. Abstract of the invention is objected because it is same as the first paragraph of the Summary. A brief abstract of the technical disclosure in the specification must commence on a separate sheet, preferably following the claims, under the heading "Abstract" or "Abstract of the Disclosure." The sheet or sheets presenting the abstract may not include other parts of the application or other material. The abstract in an application filed under 35 U.S.C. 111 may not exceed 150 words in length. The purpose of the abstract is to enable the United States Patent and Trademark Office and the public generally to determine quickly from a cursory inspection the nature and gist of the technical disclosure, see 37 C.F.R. § 1.72.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. The analysis under 35 U.S.C. 112, first paragraph, requires that the scope of protection sought be supported by the specification disclosure. The pertinent inquiries include determining (1) whether the specification disclosure as a whole is to enable one skilled in the art to make and use the claimed invention.

5. Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The enablement requirement necessitates a determination that the disclosure contains sufficient teaching regarding the subject matter claimed as to enable one skilled in the pertinent art to make and use the claimed invention. In essence, the scope of enablement provided to one ordinarily skilled in the art by the disclosure must be commensurate with the scope of protection sought by the claims.

Currently, the most prevalent standard for measuring sufficient enablement to meet the requirements of 112 is that of "undue experimentation". The test is whether, at the time of the invention, there was sufficient working procedure for one skilled in the art to practice the claimed invention without undue experimentation. It is important to note that the test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, is it undue. A skilled artisan is given sufficient direction or guidance in the disclosure. Moreover, the experimentation required, in addition to not being undue, must not require ingenuity beyond that expect of one of ordinary skill in the art.

Undue experimentation and ingenuity would be required beyond one ordinarily skilled in the art to practice for the following reasons:

- 1) Interpreting codified provisions.
- 2) Codified provisions concerning events as rules.
- 3) Evaluation functions as logical conditions.
- 4) Evaluating the rules.

For example, the current specification on page 3, lines 3-4, stated as "the interpretation of legal code, and a corporate travel policy. These two are separate entities and how they are related and how they can be interpreted. Another example, the current specification on page 4, lines 10-13, stated as "rules systems include fuzzy rules, if-then-else rules and declarative rules such as those used in the Prolog computer programming languages." In what way these rules are related to legal code and corporate travel policy.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-15, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Undue experimentation and ingenuity would be required beyond one ordinarily skilled in the art to practice for the following reasons:

- 1) Interpreting codified provisions.

- 2) Codified provisions concerning events as rules.
- 3) Evaluation functions as logical conditions.
- 4) Evaluating the rules.

### **Claim Rejections - 35 USC § 101**

8. 35 U.S.C. § 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 1-15 are rejected under 35 U.S.C. § 101, because none of the claims are directed to statutory subject matter. Independent claims 1 and 8-9 deals with simple mathematical abstract idea. A claim that recites a computer that solely calculates a mathematical formula or a computer disk that solely stores a mathematical formula is not directed to the type of statutory subject matter eligible for patent protection. These claims represent nothing more than abstract idea until reduced to some type of practical application, and thus this subject matter is not, in and of itself, entitled to patent protection. Further, these claims are not producing useful, concrete and tangible results. See *Alappat*, 33 F.3d at 1543, 31 USPQ2nd at 1556-57.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-10, 12, 26 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jeffrey (US Patent 6,493,711) hereinafter Jeffrey, and in view of Bernstein et al. (US Patent 6,728,726) hereinafter Bernstein.

12. As per independent claims 1, 8-9, McCollum teaches a rules definition language that includes statements facilitate efficient use of computer resources by allowing a rule to be broken down into one or more instructions and processing these instructions asynchronously to provide more efficient use of computer resources (page 1, paragraph [0005]). McCollum teaches the claimed, storing evaluation functions as logical conditions relating to the stored rules (page 15, paragraph [0182]). McCollum teaches the claimed, evaluating the rules using at least one of the stored evaluation functions for an event concerning the codified provisions (page 16, paragraph [0189]). McCollum does not explicitly teach codified provisions concerning events. However, Nikander teaches the claimed, storing codified provisions concerning events as rules

that use logical expressions to represent a logical structure of the codified provisions (col. 3, lines 15-25). Thus, it would have been obvious to one of ordinary skill in the data processing art at the time of the invention, to have combined the teachings of the cited references because Nikander's teachings would have allowed McCollum's method to eliminate bottleneck of performance by reducing the processing overhead consisting of looking up for policy rules from a database (col. 3, lines 47-49).

13. As per dependent claims 2, 10, McCollum does not explicitly teach mapping codes to rules. However, Nikander teaches the claimed, "the step of mapping the codified provisions to rules (Fig. 5, col. 7, lines 57-67). Thus, it would have been obvious to one of ordinary skill in the data processing art at the time of the invention, to have combined the teachings of the cited references because Nikander's teachings would have allowed McCollum's method to eliminate bottleneck of performance by reducing the processing overhead consisting of looking up for policy rules from a database (col. 3, lines 47-49).

14. As per dependent claims 3, 11, McCollum teaches the claimed, the step of restricting the rules that are evaluated using the evaluation functions (Fig. 2, page 3, paragraph [0034]).

15. As per dependent claims 4, 12, McCollum teaches the claimed, the steps of extracting rules system parameters from text of the codified provisions; and populating



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rules system templates using the extracted rules system parameters (page 8, paragraph [0099]).

16. As per dependent claims 5, 13, McCollum teaches the claimed, the rules are expressed in a scripting rules system (page 9, paragraph [0104]) .

17. As per dependent claims 6, 14, McCollum teaches the claimed, the rules are expressed in the if-then-else rules system (page 9, paragraph [0108]).

18. As per dependent claims 7, 15, McCollum teaches the claimed, the codified provisions relate to a legal code (page 15, paragraph [0188]).


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sathyanarayan Pannala whose telephone number is (571) 272-4115. The examiner can normally be reached on 8:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Sathyanarayan Pannala  
Examiner  
Art Unit 2164

srp  
May 14, 2006